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IN THE

Supreme Court of the United States

OCTOBER TERM, 1942.

No. 377

RONNING MACHINERY COMPANY and
THE GALION IRON WORKS AND
MANUFACTURING COMPANY,
Petitioners and Appellants Below,

vs.

CATERPILLAR TRACTOR CO.,
Respondent and Appellee Below.

PETITIONERS' REPLY BRIEF ON PETITION FOR WRIT OF CERTIORARI

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Petitioners, by way of reply to Respondent's brief, respectfully submit the following:

The record shows that during the twelve years that Winsor's application was pending in the Patent Office it was involved for approximately seven years in two protracted interferences (Interference No. 51,565 with

the party Myers was declared on Oct. 16, 1924 R. 1377-8, final court decision was dated Nov. 23, 1927, R. 1374, Winsor winning; Interference No. 60,337 was declared on Sept. 17, 1930 with Ronning et al., R. 1452-5, final court decision was dated May 15, 1935, R. 1451, Winsor winning). Winsor's **urgent request** for early issuance of his patent was denied by the Patent Office. As early as July 14, 1924 (R. 1362-63) Winsor stated "It is earnestly urged and respectfully hoped, that this case can now be passed to allowance".

Respondent's assertion that "**most** of the claims sued on herein were inserted in the application" (Respondent's brief p. 4) in July and September of 1935 is apt to be very misleading. Claims **2 to 10** here in suit were added to the Winsor application on July 27, 1929 (R. 1415) **before** Caterpillar **started** designing its infringing devices. In fact, these claims 2 to 10 of Winsor were copied from Ronning patent No. 1,706,256 under which Caterpillar was a licensee from August 1, 1930 until March 1, 1936, paying royalties in excess of $75,000.00 part of which was on the **identical machines** here involved. This license was cancelled by a letter written by its Vice-President, Oscar L. Starr, and dictated by its attorney, Charles M. Fryer (R. 605), in which Caterpillar stated: "In view of the recent issuance of the Winsor patent No. 2,020,271 containing claims under which we formerly paid royalty to you, — etc." we hereby elect to cancel the license agreement. (Paragraph XXII of the Complaint, R. 19-20, and Answer, R. 36-7; Pls' Exh. No. H.-613, R. 1689-93; Pls' Interrogatories Paragraphs XIV and XV, Pls' Exh. 610, R. 1679; and Def. Answers, Pls' Exh. 612, R. 1696).

Another important fact in connection with the case of *Galion* v. *Beckwith,* 25 Fed. Supp. 73; on appeal 105 Fed. (2d) 941, not mentioned by Respondent, was that these claims 2 to 10 of Winsor were **not** involved, and when Galion sought to have them included by amending its bill of particulars Caterpillar asserted "Winsor's claims two to ten in effect new and different cause of action requiring different preparation and defense from those applying to claims specified in bill of particulars now standing in case —" (Pls' Exhs. 520 and 536, R. 1273-4; 1526-7) so Galion withdrew its motion to prevent postponement of the trial of the case (R. 1128-30).

It is therefore clear that there **are not** uniform decisions in two circuits on claims 2 to 10 of Winsor. In fact, a reading of the decisions in the cases of *Galion* v. *Beckwith,* 25 Fed. Supp. 73 and 105 F. (2d) 941 shows clearly that they were **founded largely** on the fact that all the claims **there involved** were added to Winsor's application in 1935. In Judge Schoonmaker's decision (25 Fed. Supp. 73) he comments on this fact in the opening statement and again on page 74 and it is the **very foundation** of his ruling of no infringement.

Petitioners again invite attention to the fact that Respondent has not attempted to point out **any** limitation in **any** claim which it asserts finds no response in its machines. Furthermore, Respondent makes no attempt to harmonize the **clear conflict** of the decisions in this case and those in the two *Galion* v. *Adams* cases, 105 Fed. (2d) 943 and 128 Fed. (2nd) 411, involving the **same patent** and many of the **same claims,** including claims 2 to 10 **not involved** in the *Galion* v. *Beckwith* suit, 25 Fed. Supp. 73 and 105 Fed. (2d) 941.

Respondent's statement at the top of page 16 of its brief that point G is urged for the first time is inaccurate. It was repeatedly urged below both in written and oral argument. Nothing need be added to the merits of Petitioners' argument on this point over that contained in the original brief on the petition.

Respectfully submitted,

HARKER H. HITTSON,
Counsel for Petitioners.

October 7, 1942.